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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

08071.0007-00

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Typed or printed name _____

Application Number

09/986,907

Filed

11/13/01

First Named Inventor

Takeshi MITSUISHI et al.

Art Unit

2872

Examiner

Joshua Pritchett

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

06 December 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No. 22,852
Attorney Docket No. 08071.0007-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Takeshi MITSUISHI et al.) Group Art Unit: 2872
Application No.: 09/986,907) Examiner: Joshua Pritchett
Filed: November 13, 2001)
For: COMPOSITION FOR VAPOR) Confirmation No.: 6647
DEPOSITION, METHOD FOR)
FORMING AN ANTIREFLECTION)
FILM, AND OPTICAL ELEMENT)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop AF

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

A Pre-Appeal Brief Conference is requested in this application in accordance with the USPTO Notice dated June 20, 2005.

Claims 1, 3, 4, and 6-20 are pending. Claims 6-8, 9-17/6 and 9-17/8 have been indicated to be directed to allowable subject matter.

Clear error is present in the objection of claims 3, 4, 6-8, 9-17/6 and 9-17/8 because these claims include parenthetical statements, which the Examiner constructively suggests can be cured by setting out the identical statements in commas. There is no basis or reason for objecting to the form of these claims, and the Examiner's apparent preference for commas rather than parentheses does not make these claims objectionable.

Clear error is present in the rejection of claims 1-5 under 35 U.S.C. § 102(e) as being anticipated by Belleville et al. (U.S. Patent No. 6,387,517). Claims 2 and 5 were canceled prior to the final Office action as recognized in the Summary of the Final Office action. Claims 1 and 3 are representative and are reproduced below:

1. A composition comprising niobium oxide, zirconium oxide, yttrium oxide, and aluminum oxide.
3. A composition comprising zirconium oxide, yttrium oxide and from 60 to 90 % by weight of niobium oxide (calculated in terms of Nb_2O_5) based on the total amount of the composition.

The Office has relied on the teachings of Belleville et al. at col. 7, lines 4-15, as providing the basis for this anticipation rejection. Anticipation requires that each limitation of the claim be identically described or disclosed in the prior art. Belleville et al. does not describe the recited combination of oxides, but only provides a broad shotgun type disclosure that could include the claimed combination IF the appropriate oxides were selected, and in the appropriate amounts to satisfy the limitations of claims 3 and 4. This is factually and legally insufficient to constitute anticipation.

The Office position that a broad generic disclosure would inherently disclose all species necessarily embraced by that genus is wholly meritless whether considered under 35 U.S.C. § 102 or § 103. *Corning Glass Works v. Sumitomo Electric*, 868 F.2d 1251, 1262, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989). There is no basis in the Belleville et al. disclosure from which a person skilled in this art would immediately envision the claimed combination of oxides. See MPEP 2131.02 and cases cited therein. Unlike the *Petering* and *Schaumann* cases, there are no preferences ascertainable from the Belleville et al. disclosure that would lead to the claimed combination of oxides. In fact, the opposite is true since none of the examples in Belleville et al. contain even a single

oxide (of a minimum of three) recited in these claims. A broad generic disclosure with examples that all lead away from the claimed combination cannot anticipate these claims.

Clear error is present in the rejections of claims 9-14/1, 9-14/3, 9-14/4 and claims 15-17/1, 15-17/3, 15-17/4, 19 and 20 that rely on the combination of Belleville et al. (U.S. Patent No. 6,387,517) and Rahilly (U.S. Patent No. 4,116,717). Claims 9/1, 9/3, 13/1 and 13/3 are representative and are reproduced below:

9. A method for forming an antireflection film comprising sintering the composition of any one of claims 1, 3, 4, 6 or 8, vaporizing the resulting oxide, and depositing the vapor on a substrate.
13. An antireflection film comprising, in an alternating fashion, at least one layer of silicon dioxide and at least one layer obtainable according to the method of claim 9.

The combination of Belleville et al. and Rahilly fail to establish a *prima facie* case of obviousness at least because they fail to provide either a motivation or expectation of success in (1) combining the recited oxides and (2) following the procedure of sintering the combination followed by vaporizing the resulting oxide and depositing the vapor on a substrate. As noted above, Belleville et al. contains a broad generic disclosure that does not establish a *prima facie* case of obviousness because there is no motivation to select either the recited combination of oxides, or the specific proportions when recited, and the only examples described in Belleville et al. (i.e., all examples contain either tantalum oxide alone or in combination with silicon dioxide) or any other preference suggested does not include even one (out of a minimum of three) of the claimed oxides. Rahilly suggests only tantalum oxide or silicon oxide (col. 3, lines 23-28), and provides

neither motivation nor expectation that the recited combination of oxides would be useful for any purpose.

The arguments addressing the additional reasons why Belleville et al. and Rahilly cannot be properly combined and fail to provide either the motivation or expectation of success that would render the claimed invention obvious are set forth on pages 3-5 of the reply filed July 29, 2005. These arguments are incorporated herein by reference.

Applicants request withdrawal of all outstanding rejections and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this request and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 6, 2005

By: Charles E. Van Horn
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